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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,259	02/02/2001	Olle Inganas	P66218US0	8356
136	7590	03/10/2004	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			OLSEN, ALLAN W	
			ART UNIT	PAPER NUMBER
			1763	

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/720,259

Applicant(s)

INGANAS ET AL.

Examiner

Allan W Olsen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

**DETAILED ACTION**  
***Election/Restrictions***

Applicant's election with traverse of the Group II invention (claims 14-25) in the paper filed 11/18/2003 is acknowledged. The traversal is on the grounds the inventions are exact inverse analogues and that the methods of the Group I and Group II sets of claims can be subsumed under the same scope and spirit. For reasons discussed below, this is not found persuasive.

The determination of whether or not claims to different methods may be subjected to a restriction requirement depends upon whether or not the methods in question possess a shared special technical feature. As initially noted by the International Search Authority, the Group I and Group II methods do not share a special technical feature. It is noted that Applicant's traverse failed to identify a special technical feature that is shared by the two methods.

Applicants arguments are suggestive of the notion that, because the inventions are "exact inverse analogues" and because they are so much of the same scope and spirit, the invention of group I would be obvious in view of the group II invention and vice versa. If Applicant does in fact hold the view that the inventions of Groups I and II are obvious variants and if Applicant clearly admits on the record that this is the case, the restriction requirement would likely be withdrawn. Thereafter, should the examiner find one of the inventions unpatentable over the prior art, Applicant's admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. Alternatively, if Applicant does not believe one invention to obvious in view of the other, this would

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support the propriety of the restriction requirement because each invention would require its own independent search.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Objections***

Claim 25 is objected to because the recitation of dependency upon "claims 14" should read --claim 14--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 14 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Rogers et al. in Advanced Materials, 1999 Vol,11 No. 9, pages 741-745 (hereinafter, Rogers).**

Rogers teaches micro-contact printing with a stamp that comprises a patterned photoresist onto which a thin polymeric film is provided. Rogers teaches transferring the thin polymeric film onto a surface such that the transferred portion of the polymer film corresponds to the pattern of the photoresist upon which the polymer film was provided. Rogers teaches using such stamps in a process that is used to create a

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masking layer over a thin gold film so that the gold may be patterned by etching. See figure 4a and corresponding text on page 742 (immediately below Fig. 2).

**Claims 14 - 24 are rejected under 35 U.S.C. 102(b) as being anticipated by James et al. in Langmuir, 1998, 14, 741-744 (hereinafter, James).**

James teaches micro-contact printing of a polymer by applying a polymer coated stamp to a substrate. James teaches plasma etching the substrate to increase adhesion between the substrate and the polymer. James teaches plasma etching the stamp to decrease the adhesion between the stamp and the polymer. James teaches printing by stamping with aqueous based protein (polymer) solutions. See entire document.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allan Olsen whose telephone number is 571-272-1441. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Mills, can be reached on 571-272-1439.

The fax number for TC1700 is 703-872-9306 (non-after finals and after-final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1300.

Allan Olsen, Ph.D.  
February 9, 2004

A handwritten signature in black ink, appearing to read "Allan Olsen", is written over the typed name and date.